

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Kiyotaka Matsuno, et al.	Examiner:	Michael G. Mendoza
Serial No:	10/072,721	Art Unit:	3734
Filed:	February 6, 2002	Docket:	15252
For:	CLIPPING DEVICE	Dated:	September 17, 2010
Conf. No.:	1963		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO EXAMINER'S ANSWER

Sir:

In response to the Examiner's Answer dated July 30, 2010, pursuant to 37 CFR 41.41, Appellants submit this Reply to request consideration in light of the following remarks:

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being deposited with the United States Patent & Trademark Office via Electronic Filing through the United States Patent and Trademark Office e-business website on the date set forth below.

Dated: September 17, 2010

/Thomas Spinelli/
Thomas Spinelli

REMARKS

Appellants submit this Reply pursuant to 37 C.F.R. 41.41, in response to the Examiner's arguments set forth in the Examiner's Answer.

In the Examiner's answer, at paragraph 10, the Examiner argues that the "Appellant recites the purported merits of the instant invention, but has provided no evidence that such advantages are unpredictable or unexpected" and that "Appellant has not distinctly and specifically pointed out the errors in the ... rejections..." In response, Appellants submit the following.

The Appellants respectfully submit that the claimed invention patentably distinguishes over Matsuno for at least the following reasons. According to the claimed invention, after a living tissue is clipped by the clip unit at the distal end of the coupling member and the clip unit is disconnected from the coupling member, "the clipping device" as a whole including the coupling member and the actuating wire is disposed of. On the other hand, in Matsuno, the clip unit including the coupling member is re-connectably disconnected from the actuating wire.

In other words, Matsuno discloses a structure "which can replace the clip unit with another clip unit at the distal end of the actuating wire." In contrast, a feature of the inventions recited in claims 73 and 90 is the structure "which cannot replace the clip unit with another clip unit at the distal end of the actuating wire." Matsuno neither discloses nor suggests the structure "which cannot replace the clip unit with another clip unit at the distal end of the actuating wire."

Thus, the Appellants respectfully submit that the claimed invention patentably distinguishes over Matsuno in structure and cannot be obvious over Matsuno.

However, in paragraph 3 of the Examiner's Answer, the Examiner argues that "It would have been obvious to one having ordinary skill in the art at the time the invention was made to connect the wire and coupling member as recited in the claims because the particulars of the connection are a mere design choice."

Matsuno discloses "Further, the coupling member can be engaged with and disengaged from the main body of the device..." at column 1, lines 25 and 26; "A clip device of the first embodiment comprises a cassette-type clip unit 1 as shown in FIG. 1, and a clip operating device 6 as shown in FIG. 3" at column 2, lines 60-62; "After the pin 15 of the retainer 11 is fitted in the large-diameter opening 3f of the coupling plate 3 of the clip unit 1, the entire clip unit 1 is pulled toward the distal end side. Then, the head portion 16 of the pin 15 is engaged with the small-diameter opening 3g of the coupling plate 3" at column 5, lines 12-16; "Then, the slider 12 is pushed towards the distal end side to protrude the retainer 11 from the coil sheath 7, and the coupling plate 3 with the hook portion 3A stretched as shown in FIG. 2(B) is removed from the retainer 11" at column 6, lines 6-10; and "Further, after the clip is left on the living tissue since the pressure between the coupling member and the inner wall of the squeezing ring has completely disappeared, the coupling member can be removed easily from the clip device" at column 7, lines 28-32.

From the "BACKGROUND OF THE INVENTION" section of Matsuno, including the description at column 1, lines 25 and 26, Matsuno is clear that the actuating wire is the reusable type, which is produced on the assumption that a new clip unit including a coupling member is attached to the distal end of the actuating wire after the old one is detached therefrom. An indispensable condition for a clipping device of the reusable type is that the coupling member is engageable with and disengageable from the distal end of the actuating wire. This is clearly evident from at least the descriptions of Matsuno cited above.

Therefore, any design choice based on the specification and drawings of Matsuno must be a structure “which can replace the clip unit with another clip unit at the distal end of the actuating wire.” In contrast, the inventions recited in claims 73 and 90 of the present application have a structure “which cannot replace the clip unit with another clip unit at the distal end of the actuating wire.” Therefore, the inventions recited in claims 73 and 90 cannot be obvious over Matsuno or a predictable variation of Matsuno. From Matsuno, which is not based on the assumption of using a disposable clip unit, even a person skilled in the art could not have conceived the claimed invention wherein the clipping device is disposable. Consequently, the Examiner’s opinion that the inventions recited in claims 73 and 90 would have been obvious over Matsuno as a mere design choice is erroneous and must be reversed.

Accordingly, Appellants again respectfully submit that independent claims 73 and 90 patentably distinguish over Matsuno and are allowable and that claims 74-89 and 91-94 are at least allowable therewith.

In view of the remarks submitted hereinabove and in Appellants previously submitted Appeal Brief, the references applied against Claims 73-94 on appeal do not render those claims unpatentable under 35 U.S.C. § 103(a). Thus, Appellants submit that the § 103(a) rejections are in error and must be reversed.

Respectfully submitted,

/Thomas Spinelli/

Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm